REMARKS

Upon entry of this amendment, claims 1-23 are all the claims pending in the application.

By this Amendment, Applicant amends claims 1-20. These amendments are being made to conform the claims to US practice and to broaden the scope of the claims. Since such amendments are made to correct minor, basic elements, Applicant respectfully submits that that they do not raise any Festo implications.

In addition, by this Amendment, Applicant adds claims 21-23. Claims 21-23 are clearly supported throughout the specification, for example see pages 7-8 of the Specification.

I.   Preliminary Remarks

Applicant thanks the Examiner for acknowledging the claim to foreign priority and for confirming that the certified copy of the priority document was received. Applicant also thanks the Examiner for initialing the references listed on form PTO-1449 submitted with the Information Disclosure Statement filed on March 19, 2001.

The Examiner has rejected claims 1-20 under 35 U.S.C. § 112, second paragraph, claims 1-5, 8-15 and 18-20 under 35 U.S.C. § 102(e) and claims 6-7 and 16-17 under 35 U.S.C. § 103(a). Applicant respectfully traverses these rejections in view of the following comments.

II.   Claim Rejections under 35 U.S.C. § 112

Claims 1-20 stand rejected under 35 U.S.C. § 112, second paragraph because they are in a narrative form and do not contain positively recited steps of a specific process. In short, the claims are not in conformance with the US practice. Applicant thanks the Examiner for pointing

out with particularity the reasons for rejecting the claims. With respect to claims 1-20, Applicant

respectfully submits that claims 1-20 are now sufficiently definite in view of these self-

explanatory amendments made to the claims. Applicant, therefore, respectfully requests the

Examiner to withdraw this rejection.

III. Claim Rejections under 35 U.S.C. § 102(e)

Claims 1-5, 8-15, 18-20 stand rejected under 35 U.S.C. § 102(e) as being anticipated by

U.S. Patent No. 6,611,694 to Oltedal et al. (hereinafter "Oltedal"). Applicant respectfully

requests the Examiner to reconsider and to withdraw this rejection in view of the comments,

which follow.

Claims 1-5 and 8-10

Of these claims, only claim 1 and 2 are independent. To begin, independent claim 1,

original and as now amended, recites:

```
if said first coding mode is not compatible
with said tandem free operation mode,
changing said first coding mode to a second
coding mode which is compatible with said
tandem free operation mode; and

using said tandem free operation mode with
said second coding mode.
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The Examiner asserts that claim 1 is directed to a method of using tandem free operation

(hereinafter TFO) mode and is anticipated by Oltedal. The Examiner asserts that Oltedal's

preferred and default bearer capabilities are similar to using TFO with the second coding mode

when said TFO is impossible with the first coding mode (see page 4 of the Office Action).

Applicant respectfully disagrees with the Examiner. Applicant has carefully studied Oltedal's

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discussion of a method for improving speech quality for Voice over IP including its discussion of

a bearer capability and a gateway, which are not similar to using TFO with the second coding

mode when the TFO is impossible with the initial coding mode as set forth in claim 1.

Oltedal teaches avoiding deterioration of speech quality by having means for either

putting the Transceiver and Rate Adapter Unit (TRAU) in a transparent mode or letting the

TRAU be bypassed altogether (see *Abstract*). In particular, Oltedal teaches a mobile station

(MS) encoding the speech either in Half Rate Speech Coding (HR), Full Rate Speech Coding

(FR) or Enhanced Full Rate Speech Coding (EFR) and transmitting the speech samples directly

onto the IP network where they are assembled into Realtime Transfer Protocol (RTP)/User

Datagram Protocol (UDP) packets (col. 3, lines 34 to 40).

In Oltedal's base station subsystem (BSS) the Bearer Capability (BC) field is used, which

is read by the Mobile Switching Centre (MSC) and mapped transparent to the User Service

Information (USI) field on ISUP towards the VoIP Gateway. The BC contains two fields for

negotiation during a call set-up. If the gateway (GW) does not support the preferred BC, the

default BC is applied (col. 3, lines 45 to 51). Specifically, the preferred field could contain

"TFO wanted" and the default field "no TFO". VoIP GW decides which operating mode to use

(TFO or not), and reads the codec type (col. 3, lines 55 to 58).

In short, Oltedal teaches that GW decides whether the preferred operating mode can be

used or whether the default operating mode must be used. However, Oltedal only teaches that

when a preferred operating mode cannot be used, a default operating mode will be selected. That

is, bearer capability just specifies the type of operating mode to be used.

The Examiner asserts that Oltedal teaches that coding modes that support TFO are HR, FR and EFR (see page 4, lines 3-4 of the Office Action). The Examiner further asserts that if Oltedal's gateway does not support the preferred bearer capability (which the Examiner equates with coding mode that do not support TFO, page 4, line 10 of the Office Action), then the default field/coding mode that support TFO is applied (page 4, lines 10-13 of the Office Action). Applicant respectfully disagrees.

Oltedal teaches that bearer capability is the operating mode and not the code mode. The preferred bearer capability is described as TFO wanted and default bearer capability is described as No TFO. Moreover, Oltedal teaches BC containes two fields, one is fallback (default), another is preferred. The preferred BC is encoded with "TFO wanted", and the codec type (col. 3, lines 63 to 65). The gateway decides TFO or not and reads the codec type (col. 4, lines 1 to 3).

That is, Oltedal is no different from the prior art, Oltedal's gateway just checks whether TFO may be used with this code type and if so, uses TFO but if not uses some default operating mode, not TFO (e.g., tandem operating mode, TO). In short, Oltedal only teaches selecting proper operating mode for the code type and fails to teach or suggest changing the codec type to achieve TFO mode. In Oltedal, when TFO is not supported by the initial coding mode, a different operation mode will be used, no change in coding modes occur.

Therefore, *if said first coding mode does not support said tandem free operation mode, changing said first coding mode to a second coding mode which supports said tandem free operation mode* as set forth in claim 1 is not suggested or taught by Oltedal, which lacks

changing coding types in case the initially selected coding type does not support TFO. For at

least this reason, Applicant respectfully submits that independent claim 1 is patentably

distinguishable from Oltedal. Applicant, therefore, respectfully requests the Examiner to

withdraw this rejection of independent claim 1.

Next, Applicant respectfully addresses the rejection of the independent claim 2.

Independent claim 2 recites:

```
if said first coding mode is not compatible
with said tandem free operation mode,
changing said first coding mode to a second
coding mode which is compatible with said
tandem free operation mode;...
```

This recitation is somewhat similar to the recitation of using tandem free operating mode with a

second coding mode when tandem free operating mode is impossible with the initial (first)

coding mode recited in claim 1. Since claim 2 contains features that are similar to the features

argued above with respect to claim 1, those arguments are respectfully submitted to apply with

equal force here. For at least substantially the same reasons, therefore, Applicant respectfully

requests the Examiner to withdraw this rejection of independent claim 2. Finally, Applicant

respectfully submits that claims 3-5 and 8-10 are allowable at least by virtue of their dependency

on claim 2.

Claims 11-15 and 18-20

Applicant respectfully traverses this rejection now with respect to claims 11-15 and 18-

20. Of these claims, only claims 11 and 12 are independent. Independent claims 11 and 12,

recite:

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> means for replacing said first coding mode
> if said first coding mode is not compatible
> with said tandem free operation mode, to a
> second coding mode which is compatible with
> said tandem free operation mode...

This recitation is somewhat similar to the limitation of using tandem free operating mode with a

second coding mode when tandem free operating mode is impossible with the initial (first)

coding mode recited in claim 1. Since claims 11 and 12 contain features that are similar to the

features argued above with respect to claim 1, those arguments are respectfully submitted to

apply with equal force here. For at least substantially the same reasons, therefore, Applicant

respectfully requests the Examiner to withdraw this rejection of independent claims 11 and 12.

Also, Applicant respectfully submits that claims 13-15 and 18-20 are patentable at least by virtue

of their dependency on claim 12.

IV.   Claim Rejections under 35 U.S.C. § 103(a)

Claims 6, 7, 16, and 17 stand rejected under 35 U.S.C. § 103(a) as being anticipated over

Oltedal in view of Applicant's admitted prior art (hereinafter "APA"). Applicant respectfully

traverses this rejection with respect to the dependent upon claims 2 or 12, claims 6-7 and 16-17.

Applicant has already demonstrated that Oltedal does not meet all the requirements of

independent claims 2 and 12. APA clearly fails to cure the deficient teachings of Oltedal. APA

is being cited only for its teaching of AMR. Specifically, the Examiner asserts that "...the TFO

modes cannot be used with tge AMR....it would have been obvious for one skilled in the art

when carrying out or building the Oltedal's method/system to the unauthorized coding mode or

the AMR coding mode" (page 6 of the Office Action).

However, one of ordinary skill in the art would not have been motivated to combine the

APA and Oltedal. Oltedal deals with voice over IP. That is, Oltedal teaches that TFO generally

only deals with MS to MS calls and they do not address in an optimal way TFO over IP (col. 1,

lines 24 to 35). The APA has nothing to do with voice over IP or IP codec. In short, there is no

motivation to combine APA with Oltedal's voice over IP codec.

Clearly, the combined teachings of APA and Oltedal would not have (and could not

have) led the artisan of ordinary skill to have achieved the subject matter of claims 2 and 12.

Since claims 6-7 and 16-17 are dependent upon claims 2 and 12, respectively, they may be

patentable at least by virtue of their dependency.

V.   New Claims

In order to provide more varied protection, Applicant adds claims 21-23. Claims 21 and

22 are clearly patentable over the prior art references cited by Examiner at least because of their

recitation of means for, if said first coding mode is not compatible with a tandem free operation

mode, changing said first coding mode to a second coding mode which is compatible with said

tandem free operation mode. Claim 23 is patentable over the prior art references cited by the

Examiner, at least by virtue of its dependency on claim 22.

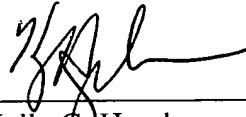**VI.   Conclusion and request for telephone interview.**

In view of the above, reconsideration and allowance of this application are now believed

to be in order, and such actions are hereby solicited. If any points remain in issue which the

Examiner feels may be best resolved through a personal or telephone interview, the Examiner is

kindly invited to contact the undersigned attorney at the telephone number listed below.

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U.S. Application No.: 09/810,216

Applicant hereby petitions for any extension of time which may be required to maintain

the pendency of this case, and any required fee, except for the Issue Fee, for such extension is to

be charged to Deposit Account No. 19-4880.

Respectfully submitted,

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WASHINGTON OFFICE
23373
CUSTOMER NUMBER

Date: February 24, 2004

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